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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,158	02/27/2004	Philip F. Spalding JR.	026818-000100US	8979
20350 7590 12/22/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER LUBIN, VALERIE				
ART UNIT		PAPER NUMBER		
3626				
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12/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,158

Applicant(s)

SPALDING, PHILIP F.

Examiner

VALERIE LUBIN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims 15-27 are pending

For reference purposes, the document paper number is 20081211

Response to Amendment

2. Applicant's arguments with respect to newly added claims 15-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 15-27 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876) and *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Applicant's method steps in claim 15 fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to transform underlying subject matter to a different state or thing.

Claim 16-27, as dependents of claim 15, are rejected under the same analysis.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman U.S. Patent No. 2001/0034619 in view of Lange Pre-Grant Pub No. 2004/0064391.

7. With respect to claim 15, Sherman recites a method comprising the steps of providing a database comprising information concerning a plurality of in-force life insurance policies (§ 10, 44); obtaining financial and medical underwriting information (§ 4, 24); categorizing underwriting information electronically (§ 10) and tracking membership records pertaining to accessing the database (§ 45).

Sherman recites locating policies whose owners are willing to entertain offers to buy additional policies (§ 46). He does not recite owners who want to sell their policies to potential buys, but Lange discloses owners selling their policies to potential buyers (§ 25). It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Lange to locate policies for which the owners want to sell their policies in order to meet the needs the buyers and sellers.

8. For claim 16, Sherman recites granting access to the database (§ 45).

9. For claim 17, Examiner showed that the combination of Sherman and Lange recites identifying owners who want to sell their insurance policies. Sherman and Lange do not specifically disclose generating electronic messages to sellers advising them of an opportunity to sell; however, Examiner takes Official Notice that generating or triggering messages to advise sellers of opportunities was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art to include the generation of electronic messages in order to advise sellers and buyers of opportunities to transact.

Claims 23 and 26 are rejected under the above analysis.

10. With respect to claim 18, Sherman recites information including personal information (¶ 45).

11. Claim 19 is rejected, as Sherman discloses an online environment including a website (¶ 10).

12. For claim 20, Examiner takes Official Notice that maintaining auctions on a website for insurance policies was old and well known in the art at the time of the invention. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman with that of the prior art in order to obtain more competitive prices on insurance policies.

13. For claim 21, Sherman recites a service of appraising in-force life insurance policies (§ 18, 48).

14. For claim 22, Sherman recites providing policy own policy owners who might want to buy additional insurance access to underwriting information (§ 45). He does not specifically recite providing access to potential buyers of the owners' insurance policies, but Lange recites owners selling their policies. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Lange to provide access to insured parties who not only want to buy additional insurance, but also who want to sell their insurance and to parties interested in buying those policies in order to facilitate transacting.

15. For claim 24, Sherman and Lange does not specifically recite tracking policies, but Examiner takes Official Notice that such a step was old and well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill to combine the prior art to track policies in order to monitor their performance and determine whether it would be beneficial to sell or buy them.

16. For claim 25, Examiner takes Official Notice that reminding insurance owners to pay their premium was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art to issue reminders to owners to pay premium in order to provide them with enough time to submit their payment and to keep their policies in proper standing.

17. For claim 27, Sherman recites allowing an owner to agent to enter information about a policy (§ 46). Sherman does not disclose calculating an approximate face value of the policy, but Lange does (§ 36). It would have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Lange to calculate the face value of a policy in order to determine the value realized by selling it. Sherman recites buying additional insurance policies (Abstract) and Lange discloses owners selling their insurance policies (§ 25). Sherman and Lange do not specifically recite displaying potential savings realized in premiums by selling a policy and buying new one at a lower premium; however Examiner takes Official Notice that displaying or reporting savings data was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Lange with the prior art to display savings realized in premiums from selling a policy and buying a new one in order to help a buyer determine how beneficial it would be to trade policies.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Weiss et al. U.S. Patent No. 6,904,410 recites generating electronic messages to notify buyers/sellers of potential opportunities and meeting desired criteria.

b) Hanby et al., U.S. Patent No. 7,143,051 discloses notifying clients being alerted via email of insurance proposals.

c) Kendall et al., U.S. Pre-Grant Pub No. 2002/0091613 discloses online auctions on insurance policies, and requesting a demonstration of a replacement policy valuation.

d) Ariathurai et al., Pre-Grant Pub No. 2002/0198743 discloses tracking insurance policies.

e) Deavers, U.S. Patent No. 6,044,352 discloses notifying clients of an upcoming premium due data and amount.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626